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Woodard, Emhardt, Moriarty, McNett & Henry LLP			GRAY, JILL M	
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The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/783,910

Filing Date: February 20, 2004

Appellant(s): CLARK ET AL.

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Kenneth A. Gandy  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 16, 2008 appealing from the Office action mailed March 20, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,139,510

PALERMO

10-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-12, 14-16, 22-24, and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Palermo 6,139,510.

Palermo teaches a medical guidewire comprising an elongate wire, an etched hydrocarbonaceous surface, wherein the hydrocarbon can be a fluoropolymer and a lubricious coating adhered thereto, as required by claims 1, 3, 5, 8, 10-12, 14-15, 22-23, and 25. The fluoropolymer is of the type contemplated by Appellants and the lubricious coating can be polyvinylpyrrolidone or a copolymer thereof, per claims 2, 6-7, and 26. See abstract, column 12, line 60 through column 13 and line 30, and Examples. In addition, Palermo teaches that indicia can be included, per claim 4 and that the lubricious coating can be a therapeutic coating, as required by claims 16 and 24. See column 5, lines 16 and column 13, lines 44-65. Regarding the limitation that the etched

surface includes oxygen-containing organic groups formed at position at which fluorine atoms have been removed, it is the examiner's position that the etched hydrocarbonaceous surfaces are substantially similar to those contemplated by applicants. Accordingly, in the absence of factual evidence to the contrary, the examiner has reason to believe that etched carbonaceous surfaces of the prior art includes oxygen-containing organic groups formed at positions at which fluorine atoms have been removed. Appellants are invited to provide such evidence.

Therefore the teachings of Palermo anticipate or in the alternative render obvious the invention as claimed in present claims 1-8, 10-12, 14-16, 22-24, and 26.

#### **(10) Response to Argument**

1. Claims 1-8, 10-12, 14-16, 22-24, and 26 anticipated under 35 U.S.C. 102(b) by Palermo

Appellants argue that the Examiner has used circular reasoning that amounts only to a statement that "the Examiner believes" that the prior art structure has all of the features of the claimed structure and has provided no technical reasoning as to why this is the Examiner's belief. Appellants further argue that conclusory statements as to an Examiner's belief are not sufficient to support a rejection for inherent anticipation since at a minimum, such a rejection requires an articulated explanation including sound technical reasoning why the claimed feature necessarily occurs in the reference, which has not been provided and thus no *prima facie* case of anticipation has been made.

In this regard, Palermo discloses that the guidewire may be pretreated with a tie layer to enhance the overall bonding of the outer polymeric surface to the core. This

treatment is done by exposing the guidewire to hydrocarbon plasma that can contain gaseous fluorocarbons resulting in a hydrocarbon or fluorocarbon residue. See column 12, line 26 through column 13, and line 30. It is the examiner's position that the plasma deposition resulting in a residue of fluorocarbon material is indicative of an "etched carbonaceous surface."

Appellants argue that the Examiner states that Palermo teaches the preparation of "etched hydrocarbonaceous surface" and "etched carbonaceous surfaces" but that Palermo contains no such teachings, rather Palermo refers to "hydrocarbonaceous residues" in its Examples which refers to a first plasma-polymerized layer on the guidewire, and that no etching of said layer is described. Appellants further argue that the Palermo teaching is to form the expected, parent polymer from the reaction of the monomers described, not some modified form thereof as specifically set forth in the instant claims and that Palermo does not teach forming a modified structure from the deposited parent polymer but teaches preserving the parent structure.

In this regard, Palermo discloses forming the hydrocarbonaceous tie layer using a plasma stream in a Plasma Etch apparatus wherein said layer is a hydrocarbon or fluorocarbon residue. It is the Examiner's position that based upon this teaching the skilled artisan would have immediately envisaged the tie layer being etched and having some degree of modification to the structure.

Appellants argue that Palermo does not teach the formed oxygen-containing organic groups in the fluoropolymer, as claimed, which facilitate bonding of the lubricious and/or therapeutic coating and that Palermo theorizes quite to the contrary

that C-C bonds are provided in the tie layer for subsequent covalent bonding to the outer hydrophilic coating.

In this regard, as set forth previously, it is the examiner's position that the etched hydrocarbonaceous surfaces are substantially similar to those contemplated by Appellants. Accordingly, in the absence of factual evidence to the contrary, the examiner has reason to believe that etched carbonaceous surfaces of the prior art includes oxygen-containing organic groups formed at positions at which fluorine atoms have been removed. Appellants have provided no evidence to the contrary.

2. Claims 1-8, 10-12, 14-16, 22-24, and 26 unpatentable Under 35 U.S.C. 103(a) Over Palermo

Appellants argue that the Examiner has not set forth any basis for the obviousness rejection and that the Examiner does assert that "the etched carbonaceous surfaces are substantially similar to those contemplated by applicants"; however, this statement was not made with any context in an obviousness rejection and thus it is unclear how to interpret the statement. Appellants further argue that the conclusion that something is "substantially similar" to that which is claimed is not a proper basis for a finding of obviousness and that factual finding by the Examiner and articulated reasoning are necessary underpinnings to establish obviousness and must be made explicit and that conclusory statements cannot support the legal conclusion of obviousness, further arguing that no such explicit factual findings and articulated reasoning have been provided, thus, no *prima facie* case of obviousness has been made.

In this regard, as set forth above, Palermo discloses that the guidewire may be pretreated with a tie layer to enhance the overall bonding of the outer polymeric surface to the core. This treatment is done by exposing the guidewire to hydrocarbon plasma that can contain gaseous fluorocarbons resulting in a hydrocarbon or fluorocarbon residue. See column 12, line 26 through column 13, and line 30. It is the examiner's position that the plasma deposition resulting in a residue of fluorocarbon material is indicative of an "etched carbonaceous surface." Accordingly, it is the Examiner's position that where the claimed and prior art products are identical or substantially identical a *prima facie* case of either anticipation or obviousness has been established, *In re Best*, 562, F.2d 1252, 1255, 195 USPW 430, 433 (CCPA 1977), and Appellants have the burden of showing that they are not. MPEP 2112.02.

Appellants argue that Palermo teaches forming the expected parent polymer from the reaction of monomers described at the top of Col. 13, not some modified form thereof as specifically set forth in the instant claims, accordingly, Palermo does not teach the formed oxygen-containing organic groups in the fluoropolymer, as claimed, which facilitate bonding of the lubricious and/or therapeutic coating, and that Palermo theorizes to the contrary, that C-C bonds are provided in the tie layer for subsequent covalent bonding to the outer hydrophilic coating, thus, Palermo is not only silent as to these claimed features, but teaches directly against them.

As set forth above, Palermo discloses forming the hydrocarbonaceous tie layer using a plasma stream in a Plasma Etch apparatus wherein said layer is a hydrocarbon or fluorocarbon residue. It is the Examiner's position that based upon this teaching the

skilled artisan would have reason to believe the tie layer being etched and having some degree of modification to the structure. Also as set forth previously, it is the examiner's position that the etched hydrocarbonaceous surfaces are substantially similar to those contemplated by Appellants. It is clear that Palermo is concerned with enhanced bonding between the outer polymeric coating and the core. Accordingly, in the absence of factual evidence to the contrary, the examiner has reason to believe that etched carbonaceous surfaces of the prior art includes oxygen-containing organic groups formed at positions at which fluorine atoms have been removed. Appellants have provided no evidence to the contrary.

Therefore, the Examiner's position remains that the teaching of Palermo anticipates or in the alternative, renders obvious the invention as claimed in present claims 1-8, 10-12, 14-16, 22-24, and 26.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jill Gray/

Primary Examiner, Art Unit 1794

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/Milton I. Cano/

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